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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Customer Number: 46320
: :
Matthias BIERBRAUER, et al. : Confirmation Number: 7481
: :
Application No.: 10/020,048 : Group Art Unit: 2178
: :
Filed: December 14, 2001 : Examiner: M. Ludwig
: :
For: METHOD AND SYSTEM FOR MOVING SINGLE DOCUMENTS BETWEEN A
DOCUMENT PROCESSING SYSTEM AND A DOCUMENT REPOSITORY

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed November 26, 2007, wherein Appellants appeal from the Examiner's rejection of claims 1-17.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on December 14, 2001, at Reel 012399, Frame 0882.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-17 are pending and six-times rejected in this Application. It is from the multiple rejections of claims 1-17 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Sixth Office Action dated August 24, 2007 (hereinafter the Sixth Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 1 and 2 and also to independent claims 1 and 10, a system and method for moving a single document 104 between a document processing system 100 and a document repository 113 is disclosed. Means obtain structural information describing the structural elements 109-112 of a sequential file 108 of documents 103-106 in which the single document 104 is located (page 6, lines 2-5 of Appellants' disclosure). Means obtain meta information describing the properties of the single document 104 (page 7, lines 1-2). Means obtain document content of the single document 104 (page 6, lines 20-21). Means create a physical representation 111 for the single document 104 based on the obtained structural information, meta information and document content (page 6, lines 5-8). Means transfer the created physical representation 111/112 to the document repository 113 (page 6, lines 8-9).

Referring to Figure 3 and also to independent claims 5 and 13, a system for moving a folder 302 and documents 303, 304 contained therein between a document processing system and a document repository 300 is disclosed. Means obtain structural information 305 describing the folder structure 301 (page 8, lines 4-6). Means obtain meta information describing the folder

properties (page 8, lines 1-4). Means create a physical representation 306 for the folder 302 based on the obtained structural information and meta information (page 8, lines 9-15). Means transfer the created physical representation 306 to the document repository 300 (page 8, lines 10-11).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-17 were rejected under 35 U.S.C. § 103 for obviousness based upon Hoffert et al., U.S. Patent No. 5,903,892 (hereinafter Hoffert).

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-17 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HOFFERT

For convenience of the Honorable Board in addressing the rejections, claims 2-4 and 10-12 stand or fall together with independent claim 1, and claims 6-9 and 13-17 stand or fall together with independent claim 5.

Claim 1

Obviousness is a legal conclusion based on underlying facts of four general types, all of which must be considered by the trier of fact: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of nonobviousness.¹ Upon reviewing the Examiner's statement of the rejection with regard to claim 1 on pages 3 and 4 of the Sixth Office Action, Appellants

¹ See KSR Int'l v. Teleflex Inc., 550 U.S. ____ (2007); Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750-51 (Fed. Cir. 1991); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1594 (Fed. Cir. 1987).

submits that the Examiner has failed to clearly designate the teachings in Hoffert being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 103 also fails to comply with 37 C.F.R. § 1.104(c), which provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The Examiner has not designated the particular parts of Hoffert being relied "as nearly as practicable." Instead, the Examiner's statement of rejection reproduces entire paragraphs of the claims and asserts that all the limitations in the particular paragraph are disclosed by certain cited passages within Hoffert. Although broadly identifying where the Examiner believes the claimed limitations are disclosed in Hoffert, the statement of the rejection fails to clearly identify many of the specific elements within Hoffert being relied upon in the rejection, as required by 37 C.F.R. § 1.104(c).

By not clearly indicating those specific elements being relied upon in the prior art to teach the invention, as recited in the claims, the Examiner has failed to fully establish the underlying facts regarding (1) the scope and content of the prior art and (3) the differences between the claimed invention and the prior art. Thus, the Examiner has improperly arrived at the legal conclusion that the claimed invention is obvious based upon Hoffert.

For example, on page 3 of the Sixth Office Action, the Examiner asserted the following as to the first claimed step:

As the crawler crawls the web, those pages, which contain media references, receive a higher priority for processing than those pages which do not reference media. Each HTML page is scanned for predetermined types of HTML tags (compare to "*obtaining structural information*

describing the structural elements of a sequential file of documents in which the single document is located"). See column 3, lines 33-67 and column 4, lines 1-45. The reference fails to explicitly state 'sequential order', regarding the structural elements of a file. However, the reference states priorities for selection of webpages which reference media. Therefore, it would have been obvious to one of ordinary skill in the art at the time the-invention was made to have modified the well known webpage selection techniques of Hoffert and utilized the priority methods for analyzing an ordered set of webpages which would provide a user with enhanced categorization of content. (emphasis in original)

Based upon this single claimed step alone, the Examiner has failed to establish a *prima facie* case of obviousness since the teachings in Hoffert cited by the Examiner and the claimed limitations at issue (i.e., the emphasized portion in the above-reproduced paragraph) are entirely different.

For ease of analysis, one can split the limitations at issue into two portions: (i) structural information is obtained that describes structural elements of a file and (ii) the file is a sequential file of documents in which "the single document" is located. Notwithstanding that the Examiner admits that the "sequential order" portion of these limitations is not disclosed by Hoffert, Appellants are entirely unclear as to exact specific feature alleged by the Examiner to disclose the claimed "file of documents in which the single document is located."

Not only does the Examiner's analysis fail to identify a feature corresponding to the claimed "file," the Examiner has failed to identify a specific teaching that corresponds to the claimed structural information of the structural elements of the file. In this regard, Appellants are unable to determine when Hoffert teaches either the structural elements of the file or the structural information of these structural elements. Upon reviewing the teachings within Hoffert cited by the Examiner, Appellants are unable to discern any teachings that could be considered as reasonably teaching these limitations. Thus, the Examiner has failed to establish that Hoffert teaches those limitations for which the Examiner is relying upon Hoffert to teach.

As to the Examiner's obviousness analysis regarding the "sequential order," Examiner's analysis refers to analyzing a set of webpages to prioritize them, presumably, in some sequence. However, even if the a set of webpages are analyzed to prioritize them in some sequence, as alleged by the Examiner, this still does not necessarily lead to a "sequential file of documents." For example, the webpages in the "set of webpages" could be scattered in different locations and not be located within a "file of documents," as claimed.

Regarding the next claimed step, the Examiner asserted the following on page 3 of the Sixth Office Action:

Each HTML page is scanned for predetermined HTML tag types. The following tags are scanned for: lists, headings, header separators (compare to "*obtaining meta information describing the properties of the single document*"). See column 4, lines 31-45. (emphasis in original)

The Examiner's analysis ignores the language of the claims. As claimed, meta information describing properties of the single document are obtained. On the contrary, although a heading itself could be considered meta information, an HTML tag of a heading is not meta information describing properties of a document. Instead, an HTML tag merely describes how a piece of data indicated by the tag is to be defined/formatted. Thus, scanning for predetermined types of HTML tags (see column 4, lines 33-34), as taught by Hoffert, does not disclose the claimed "obtaining meta information describing the properties of the single document." Therfore, Hoffert further fails to teach those limitations for which the Examiner is relying upon Hoffert to teach.

Regarding the last two steps recited in claim 1, the Examiner asserted the following on page 4 of the Sixth Office Action:

The described method for estimating motion content and brightness, contrast and color can be used together with the described algorithm for searching the worldwide Internet in order to index and intelligently tag digital multimedia content. A user could execute the query: find me all video from slow moving to fast, by Steven Spielberg, and the database engine would return a list of search results, ordered from slowest to fastest within the requested motion range (compare to "*creating a physical representation for the single document based on the obtained structural information, meta information and document content and transferring the created physical representation to the document repository*"). See column 8, lines 30-67.

Again, based upon this single claimed step alone, the Examiner has failed to establish a prima facie case of obviousness since the teachings in Hoffert cited by the Examiner and the claimed limitations at issue (i.e., the emphasized portion in the above-reproduced paragraph) are entirely different.

For ease of analysis, one can split the limitations at issue into four portions: (i) creating a physical representation; (ii) the physical representation is of the single document; (iii) the physical representation is based upon the obtained structural information, meta information and document content; and (iv) transferring the created physical representation to the document repository. Regarding the claimed "physical representation," as apparent from the Examiner's objection on page 2 of the Sixth Office Action to the term "physical," the Examiner apparently is not aware that the term "physical representation" as it pertains to document/files is a term of art known to those have ordinary skill in the art. For the Examiner to assert that this term requires correction evidences a failure, by the Examiner, to understand a basic term in the art. Appellants' position is that once the Examiner gains a better understanding as to the term of art, "physical representation," the Examiner will understand why the Examiner's cited passage within Hoffert fails to teach this limitations associated with this term.

Notwithstanding the Examiner's failure to understand the term "physical representation," the Examiner's analysis is completely silent as to an exact specific teaching within Hoffert that corresponds to this limitation. Moreover, the Examiner's analysis is silent (as is the teachings of Hoffert) as to the physical representation being of the single document. As already noted above, the Examiner has failed to establish that Hoffert teaches obtaining the claimed "structural information" or the "meta information," and thus, the Examiner has not established that the yet-to-be-identified "physical representation" is created based upon the structural information and meta information, as claimed.

As to the last step in claim 1 (i.e., transferring the created physical representation to the document repository), Appellants are again entirely unclear where Hoffert specifically teaches this limitation. Notwithstanding that Appellants are also unclear as to what feature in Hoffert corresponds to the claimed "physical representation," the passage cited by the Examiner neither refers to transferring, in general, nor transferring to a document repository. Thus, Hoffert again further fails to teach those limitations for which the Examiner is relying upon Hoffert to teach.

Claims 5-9 and 13-17

With regard to these claims, the Examiner asserted on page 5 of the Office Action, the following regarding claims 5-9:

limitations reflect similar language for moving a single document between a document processing system and a document repository as claimed in numbers 1-4. The claims are rejected under similar rationale.

The Examiner has committed gross error in making the above assertion. Claims 5-9 and 13-17 are directed to "moving a folder and documents contained therein." Claims 1-4, however, are completely silent with regard to a folder. Therefore, the Examiner's comments with regard to

claims 1-4 do not establish that Hoffert teaches or suggests all of the claimed limitations recited therein.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103 is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 26, 2007

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A method for moving a single document between a document processing system and a document repository, comprising the steps of:

obtaining structural information describing the structural elements of a sequential file of documents in which the single document is located;

obtaining meta information describing the properties of the single document;

obtaining document content of the single document;

creating a physical representation for the single document based on the obtained structural information, meta information and document content; and

transferring the created physical representation to the document repository.

2. Method according to claim 1, wherein the physical representation for the single document is a binary format.

3. Method according to claim 1 or 2, further comprising retrieving a document identifier for the moved single document and including the document identifier in the created physical representation.

4. Method according to claim 1, further comprising serializing the obtained structural information, meta information and document content into the physical representation for the document.

5. A method for moving a folder and documents contained therein between a document processing system and a document repository, comprising the steps of:

obtaining structural information describing the folder structure;

obtaining meta information describing the folder properties;

creating a physical representation for the folder based on the obtained structural information and meta information; and

transferring the created physical representation to the document repository.

6. Method according to claim 5 for moving a folder including subfolders, comprising the further step of recursively performing the steps in claim 5 for all subfolders and/or sub-subfolders.

7. Method according to claim 5 or 6, wherein the physical representation for the folder is a binary format.

8. Method according to claim 5, further comprising serializing the obtained structural information and meta information into the physical representation for the folder.

9. Method according to claim 6, wherein a folder entry contains references to all the subfolders and documents contained in it.

10. A system for moving a single document between a document processing system and a document repository, comprising:

means for obtaining structural information describing the the structural elements of a sequential file of documents in which the single document is located;

means for obtaining meta information describing the properties of the single document;

means for obtaining document content of the single document;

means for creating a physical representation for the single document based on the obtained structural information, meta information and document content; and

means for transferring the created physical representation to the document repository.

11. (Currently Amended) System according to claim 10, comprising means for retrieving the document identifier for the moved single document and including the document identifier in the created physical representation.

12. System according to claim 10 or 11, comprising means for serializing the obtained structural information, meta information and document content into the physical representation for the document.

13. A system for moving a folder and documents contained therein between a document processing system and a document repository, comprising:

means for obtaining structural information describing the folder structure;

means for obtaining meta information describing the folder properties;

means for creating a physical representation for the folder based on the obtained structural information and meta information; and

means for transferring the created physical representation to the document repository.

14. System according to claim 13 for moving a folder including subfolders, further comprising means for recursively performing the steps in claim 13 for all subfolders and/or sub-subfolders.

15. System according to claim 13 or 14, comprising means for serializing the obtained structural information and meta information into the physical representation for the folder.

16. A data processing program for execution in a data processing system comprising software code portions for performing a method according to claim 1 when said program is run on said computer.

17. A computer program product stored on a computer usable medium, comprising computer readable program means for causing a computer to perform a method according to claim 1 when said program is run on said computer.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.